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- a. forming, tightening and consolidating predetermined foodstuffs using said flexible planar member into elongated, cylindrical tubes.
  - b. separating said tubes with a cutting means utilizing said slots into individual portions.
16. The method of claim 15 wherein said cutting means is a knife.

### **Applicant Remarks, General**

By the above amendment, the title has been changed to more correctly describe the invention in view of the editing of the claims.

### **Applicant Remarks pertaining to specific rejections**

By the above, exhibited amendment, the applicant has rewritten all claims to define the invention more particularly and distinctly so as to overcome the stated rejections and define the invention patentably over prior the art.

### **1<sup>st</sup> Rejection:**

Claim Rejections – 35 USC 102(b), claims 7 & 8 were rejected as being anticipated by Isobe.

A person shall be entitled to a patent unless -  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

### **Examiner:**

There is disclosed in Isobe a device for rolling food products, where a flexible planar member (18) is rolled about foodstuff (16) and tightened into cylindrical tubes (12), and thereafter separated into individual portions (see figures 1 and 2) by cutting.

**Summary of change:** The applicant hereby narrows the scope of the method as to the method of producing the **individual portions** of the associated rolled food product, not the rolled food product itself.

Isobe discloses a method of producing the rolled food product but in no manner allows for the creation of the individual sections other than removing the “finished” product, and separating the

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rolled food product by adding steps to the process. Should the individual portions need reforming, or compression as to make the product more appealing when presented to the customer, the use of the Isobe invention would then require another step after the additional step of separating the portions.

The applicant agrees that the Isobe invention discloses a method of creating a rolled food product but solves an unrecognized problem of producing finished products (the individual portions) in their most attractive form, therefore delivering a superior product.

By it's nature and performance, the Isobe invention could not integrate a cutting function without a complete redesign. In it's specification, Isobe indicates no reason for the invention to be modified to accommodate a cutting means.

## **2<sup>nd</sup> Rejection:**

Claim Rejections – 35 USC 103(a), claims 1 thru 6 were rejected as being unpatentable over Oseka in view of Fields.

USC 103(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

## **Examiner:**

There is disclosed in Oseka a device for making rolled food products, comprising:  
a flexible bamboo mat 100 for rolling food products 122 into a cylindrical tube within another mat (120).

Fields discloses a device 210 for handling cylindrical shaped food items, the device having slots (264, 266) through a surface thereof for accommodating a cutting means.

It would have been obvious to one skilled in the art to provide the mat of Oseka with the slits taught by Fields, in order to allow cutting of the food product into pieces without damaging the entire product.

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**Summary of change:** The applicant hereby narrows the scope of the invention as to the outcome of using the claimed invention. The narrowed claims now refer to the production of the **individual portions** of the associated rolled food product, not the rolled food product itself.

Although the Oseka invention discloses a device for making the rolled food product, the separation (cutting) of the rolled food product is not addressed. As in the prior reasoning for the 1<sup>st</sup> rejection, the combining of the function to allow separation of the rolled food product during it's creation would render the Oseka invention dysfunctional.

As stated in the specification, one of the appeals of the applicant's invention is the continuity of performance in an environment that has the client observing the production of the individual portions. Per the Japanese culture, the traditional methods of food and drink are ancient and well established. The applicant's invention serves to replicate a traditional method of service with a relatively new product, such as the "California Roll" or "Inside Out Roll".

The Fields invention is stated as an invention to cut a sandwich. Also disclosed is a modification to allow cylindrical food products to be separated. Again the method that Fields relies on would allow for only one cut. Multiple separations would require repositioning of the cylindrical foodstuffs and add steps to the process. The applicant's invention allows for multiple separations. Claimed features of the applicant's invention are lacking in both Oseka and Fields. It would be necessary to make modifications to both Oseka and Fields, in order to combine the references in the manner suggested.

**Conclusion:**

For the above reasons, we submit that the specification and claims are now in proper form, and that the claims all define patentability over prior art. Therefore we submit that this application is now in condition for allowance, which action we respectfully request.

Regards,



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